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EXAMINER

YE, LIN

ART UNIT PAPER NUMBER

2615

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/821,248

Applicant(s)

SEKI ET AL

Examiner

Lin Ye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-60 is/are rejected.
- 7) ☒ Claim(s) 58-59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Response to Arguments of Election/Restrictions***

1. Applicant's election with traverse of the election of invention in Group III (claims 50-60) filed on 1/4/05 is acknowledged. The traversal is on the ground(s) that applicants believe the claims of the present invention would appear to be part of an overlapping search area and examination of the entire application would not place a serious burden on the examiner. This is not found persuasive because the examiner made a ***prima facie*** showing of examining burden by pointing out the distinct inventions. For examples, **Group I** (claims 1-40) only teaches an image input apparatus comprises image capture guide list input unit, through which image capture guide lists including at least one of **image titles**, which does not include a Web browsing unit which captures **Web information** for a Web page of a Web server as claimed in **Group II** (41-49), and which does not include a **computer** connected with an image input apparatus and a **method for creating** an image capture guide list as claimed in **Group III** (claims 50-60). This same reasoning could be performed for all of the groups. See MPEP § 806.05(d). In additional, **Group I** contains claims directed to the plurality of patentably distinct sub-species of the claimed invention.

**The requirement is still deemed proper and is therefore made Final.**

2. Claims 1-49 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group I and II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement filed on 1/04/05.

***Claim Objections***

3. Claim 50 objected to because of the following informalities:

Claim 50 recites the limitation "the screen of said display device" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 50-59 rejected under 35 U.S.C. 101 because:

The claimed invention is directed to non-statutory subject matter. Data structures not claimed as embodied in **computer-readable media** are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

For art examination purpose, these claims will be interpreted as they are best understood.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 50, 54, 56-57 and 60 is rejected under 35 U.S.C. 102(b) as being anticipated by Parulski et al. U.S. Patent 5, 633,678.

Referring to claim 50, the Parulski reference discloses in Figures 5-7, a computer (host computer) connects with an image input apparatus (camera) thereto through a transmission line (cable), comprising (See Figure 5, step 70-71): an image capture guide list creating step of creating an image capture guide list (category) which is displayed on a screen of a display device (LCD 30, see Col. 6, lines 17-20) for said image input apparatus, and includes at least one of image titles that represent targets to be recorded and are used for shooting (e.g., the step of creating categories can be considered as the step of creating an image capture guide list, because user can select one or more categories as capture guide list for a plurality of images prior to capture, and the captured digital image data corresponding to the particular category selected by the user. The categories include one of image names as image titles, See, Figures 7, Col. 7, lines 23-44).

Referring to claim 54, the Parulski reference discloses all subject matter as discussed in respect to claim 50, and the Parulski reference discloses displaying a spreadsheet type

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input screen consisting a plurality of cells; inputting an image title in one of the cells on the input screen; specifying at least one of the cell positions where image titles have been input; and creating an image capture guide list including the image title(s) on the specified cell position(s) as shown in Figure 7 (See Col. 7, lines 23-44).

Referring to claim 56, the Parulski reference discloses all subject matter as discussed in respected to claim 54, and the Parulski reference discloses inputting an image tile in one of the cells on the input screen in Figure 7, changing the size of at least a part of the cells on the input screen (e.g., as the more images adding to the list show the Figure 7, the size of the cells on the input screen are changed).

Referring to claim 57, the Parulski reference discloses all subject matter as discussed in respected with same comments to claim 56.

Referring to claim 60, the Parulski reference discloses all subject matter as discussed in respected with same comments to claims 50 and 54.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 51-53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al. U.S. Patent 5, 633,678 in view of Endsley et al. U.S Patent 6,005,613.

Referring to claim 51, the Parulski reference discloses all subject matter as discussed in respected to claim 50, except that reference does not explicitly show the image capture guide list creating step includes the steps of reading out the model name information from said image input apparatus connected to said computer and creating the image capture guide list adequate for the model.

The Endsley reference teaches in Figures 1-3, the computer (12) is connected to a camera (10); the computer reads out (reads and adjusts) the model name information (camera configuration parameters, such as the camera either motion video camera or still camera, monochrome or color camera as shown in Table 2 and 3; See Col. 6, lines 35-41 and Col. 7, lines 45-51 from the camera and creating (e.g., controlling the camera to capture image based on the camera configuration parameters can be considered as the step for creating the image capture guide list adequate for the model, see Col. 7, lines 37-42). The Ends reference is evidence that one of ordinary skill in the art at the time to see more advantages for the system reads out the model name information from the image input apparatus so that allowing flexibility in user selection of these information to creating the image capture guide list adequately between a host computer and the image input apparatus. For that reason, it would have been obvious to one of ordinary skill in the art at the time to modify the system of Parulski by providing the steps of reading out the model name information from said image input apparatus connected to said computer and creating the image capture guide list adequate for the model as taught by Endsley.

Referring to claim 52, the Parulski and Endsley references disclose all subject matter as discussed in respected to claim 51, and the Endsley reference discloses wherein the image

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capture guide list creating step includes the steps of reading out the model name information (camera parameters) from the header of the recorded file stored in said image input apparatus (stored in camera registers 72, See Col. 5, lines 3-12) and creating the image capture guide list adequate for the model.

Referring to claim 53, the Parulski and Endsley references disclose all subject matter as discussed in respected to claim 51, and the Endsley reference discloses wherein the image capture guide list creating step includes the step of creating the image capture guide list adequate for each model using a table in which model ability information (e.g., crop values, integration time, and Number of bits per sample, etc.) for each model of plural image input apparatuses is registered as shown in Table 2 and 3 (See Col. 7, lines 26-43).

Referring to claim 55, the Parulski and Endsley references disclose all subject matter as discussed in respected to claims 50-51 and 54, and the Endsley reference discloses a screen consisting a plurality of cells including a image title (clip name) and a shooting instruction item (camera setting item) for this iamge tile in respective cells on the input screen as shown in Figure 3A.

Referring to claim 56, the Parulski and Endsley references disclose all subject matter as discussed in respected to claims 50-51 and 54, and the Endsley reference discloses a screen consisting a plurality of cells including a image title (clip name) and changing the size of at least a part of the cells on the input screen (Size setting) as shown in Figure 3A (See Col. 6, lines 47-63).

Referring to claim 57, the Parulski and Endsley references disclose all subject matter as discussed in respected with same comments to claim 56.



***Allowable Subject Matter***

10. Claims 58-59 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not teach or fairly suggest displaying a spreadsheet type input screen consisting of a plurality of cells; and displaying an image title in the image capture guide list in one of the cells, reading out the size of a target cell in which the image recorded for the image title is to be pasted, changing the size of the recorded image to the size of the read-out cell, and pasting the recorded image in the target cell, used in combination with all of the other limitations of the claims 50 and 58.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Narayan et al. U.S 6,035,323 discloses an apparatuses for publishing a collection of digital media on a network.
  - b. Levine et al. U.S 2003/0177448 discloses a method inserting a image captured by input image apparatus into application program documents, including spreadsheet.
  - c. Anderson et al. U.S. 6,567,122 discloses a method and system for implementing internet access to images stored in a digital image capture unit.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Ye whose telephone number is (571) 272-7372. The examiner can normally be reached on Mon-Fri 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lin Ye  
Examiner  
Art Unit 2615

May 24, 2005